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10/583,687

06/19/2006

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EXAMINER

ULLAH MASUD, MOHAMMAD R

ART UNIT

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3687

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|-------------------------------------|--|
| Office Action Summary | Application No. 10/583,687 | Applicant(s) HELD, WALTER | |
| | Examiner MOHAMMAD R. ULLAH MASUD | Art Unit 3687 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 03029455.7.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/19/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

- Claims 1-14 were “canceled”.
- Claims 15 – 33 are “new” and currently pending in the application.

Information Disclosure Statement

The Information Disclosure Statement submitted by the applicant on June 19, 2006 was considered by the examiner.

Drawings

The drawing was received on June 19, 2006. The drawing is accepted by the Examiner.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15 – 30, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The preamble of these recite a method, however the body of the claims do not positively tie the process steps to said apparatus.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 15 - 33** rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (US 6,529,593), in view of Gonthier et al. (US 2002/0165783) (hereinafter referred to as Gonthier).

With respect to **claims 15, 27, and 31** Nelson discloses a method for using a proxy device to charge for a service in a communication network (see, for example, column 3 lines 28-48), comprising:

receiving a charge acknowledge response from the client (see, for example, column 6 lines 40 - 55);

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performing a charge registration for the ticket in response to the charge acknowledgement response (see, for example, column 6 lines 40 - 57); and

sending a request for a charge acknowledgement to the client (see, for example, column 6 lines 40 - 55), but Nelson does not explicitly disclose a method comprising, receiving a request for a service from a client, performing an authentication of the client in response to receiving the service request, sending the client a reference to an application server in response to a successful authentication, the application server providing the requested service, and receiving from the application server a ticket having information relating the charges for the service.

However, Gonthier discloses a method, comprising:

receiving a request for a service from a client (see, for example, paragraph [0013]);

performing an authentication of the client in response to receiving the service request (see, for example, paragraph [0032] - [0042]);

sending the client a reference to an application server in response to a successful authentication, the application server providing the requested service (see, for example, paragraph [0032] - [0048]);

receiving from the application server a ticket having information relating the charges for the service (see, for example, paragraph [0056] - [0063]).

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of invention to have modified the method of Nelson, in accordance with the teachings of Gonthier, in order to charge for a service in a communication network comprising, receiving a request for a service from a client, performing an authentication of the client in response to receiving the

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service request, sending the client a reference to an application server in response to a successful authentication, the application server providing the requested service, and receiving from the application server a ticket having information relating the charges for the service, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

With respect to **claim 16**, Nelson discloses a method, wherein the charges occur during the use of the service (see, for example, column 7 lines 50-61).

With respect to **claim 17**, Nelson discloses a method, wherein the charges occur before the use of the service (see, for example, column 7 lines 4-7).

With respect to **claim 18**, Nelson discloses a method, wherein the charge registration includes updating a credit status or charge status of the client (see, for example, figure 3a, column 7 lines 16-40).

With respect to **claim 19**, Nelson discloses a method, wherein the charge registration includes storing the ticket for a subsequent billing (see, for example, column 3 lines 28-48).

With respect to **claim 20**, Nelson discloses a method, further comprising notifying the client of charges included for the charge registration (see, for example, column 6 line 45 – column 7 line 3).

With respect to **claim 21**, Nelson discloses a method, for using an application server to charge for a service in a communication network (see, for example, column 3 lines 28-48), comprising:

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receiving a message from the proxy device indicating if the ticket was acknowledged by the client (see, for example, column 6 lines 40 – 55); and

maintaining the service relationship for the client if the message indicates the ticket was positively acknowledged (see, for example, column 7 lines 50 – 60), but Nelson does not explicitly disclose a method comprising, receiving a service request from a client, the service request including a reference to a proxy device, creating a ticket in response to the service request, the ticket including information about the charges due to the client for the service, and sending a service acceptance to the client, whereby a service relationship is established between the application server and the client.

However, Gonthier discloses a method comprising: receiving a service request from a client, the service request including a reference to a proxy device (see, for example, paragraph [0051] – [0054]);

creating a ticket in response to the service request, the ticket including information about the charges due to the client for the service (see, for example, paragraph [0055] – [0063]);

sending a service acceptance to the client, whereby a service relationship is established between the application server and the client (see, for example, paragraph [0055]);

sending the ticket to the proxy device (see, for example, paragraph [0055] – [0063]).

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of invention to have modified the method of Nelson, in accordance with the teachings of Gonthier, in order to charge for a service in a communication network comprising, receiving a service request from a client, the service request including a reference to a proxy device, creating a ticket

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in response to the service request, the ticket including information about the charges due to the client for the service, and sending a service acceptance to the client, whereby a service relationship is established between the application server and the client, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

With respect to **claim 22**, Nelson discloses a method, wherein the ticket indicates the charges occur during the use of the service (see, for example, column 7 lines 50-61).

With respect to **claim 23**, Nelson discloses a method, wherein the ticket indicates the charges occur before the use of the service (see, for example, column 7 lines 4-7).

With respect to **claim 24**, Nelson discloses a method, further comprising ending the service relationship to the client if the message indicates that the ticket was negatively acknowledged (see, for example, column 7 lines 50 – 60).

With respect to **claim 25**, Nelson discloses a method, further comprising ending the service relationship to the client if the message indicates that ticket was not acknowledged (see, for example, column 7 lines 50 – 65).

With respect to **claim 26**, Nelson discloses a method, further comprising ending the service relationship to the client if proxy device notifies the server that a sufficient credit is not available in the case of a pre-paid client (see, for example, column 7 lines 50 – 65).

With respect to **claim 28**, Nelson discloses a method, further comprising displaying the charges to an end user (see, for example, column 3 lines 49-56).

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With respect to **claim 29**, Nelson discloses a method, wherein the charges are displayed in real time (see, for example, column 3 lines 49-56).

With respect to **claim 30**, Nelson discloses a method, further comprising receiving a response from the end user pertaining to the charges (see, for example, column 6 lines 52 -55).

With respect to **claims 32, and 33** Nelson discloses a method, further comprising:
maintaining the service relationship if the billing information is positively acknowledged (see, for example, column 7 lines 50 – 60), and ending the service relationship if the billing information is negatively acknowledged (see, for example, column 7 lines 50 – 60), but Nelson does not explicitly disclose an invention, further comprising: forwarding the acknowledgement of the billing information to the application server.

However, Gonthier disclose an invention, further comprising:
forwarding the acknowledgement of the billing information to the application server (see, for example, paragraph [0045] – [0050]).

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of invention to have modified the method of Nelson, in accordance with the teachings of Gonthier, in order to charge for a service in a communication network comprising, forwarding the acknowledgement of the billing information to the application server, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD R. ULLAH MASUD whose telephone number is (571)270-5390. The examiner can normally be reached on MONDAY TO THURSDAY 9.00 AM TO 5.30 PM (EASTERN TIME).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW S. GART can be reached on (571)272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. U./
Examiner, Art Unit 3687

/Elaine Gort/
Primary Examiner, Art Unit 3687